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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,948

06/01/2006

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EXAMINER

HUR, ECE

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2179

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,948	Applicant(s) TAKAKUWA ET AL.	
	Examiner ECE HUR	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-17,21,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-17,21,22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/11/2006, 12/29/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to application filed on December 29, 2005 in which Claims 1 to 24 are presented for examination. This application is a 371 of PCT/ JP04/09487, filed on June 29, 2004. Applicant is claiming priority for the application Japan 2003-189821 filed on July 1, 2003.

Status of Claims

Claims 1, 3-12, 14-17, 21-22 and 24 are pending in the case. Claims 1, 9, 11, 12, 17, 21, 22 and 24 are the independent Claims.

Claims 1, 3, 4, 5, 6, 8 -12, 14-17, 21, 22, 24 are rejected under Double Patenting. Claim 21 and 22 are rejected under 35 U.S.C. 112, second paragraph.

Claim 21, 22 and 24 is rejected under 35 U.S.C. 101.

Claims 1, 3-12, 14-17, 21-22 and 24 are rejected under 35 U.S.C. 102(b).

Information Disclosure Statement Acknowledgement

The information disclosure statement filed on October 11, 2006 and December 29, 2005 are in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, the information referred to therein has been considered as to the merits.

Specification Objection

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

Drawings Objection

Due to the lengthy specification the drawings has not been checked to the extend necessary to determine whether the drawings are comply with 37 CFR 1.84(p) (4) and (p) (5).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 5, 6, 8 -12,14-17, 21, 22, 24 of the currently examined application (10/562,948) provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3, 5, 6, 7, 8-21 of copending Application No. (10/562,820). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention. Exemplarity Claim 5 from both applications is provided in Table 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Table 1

Current Application: 10/562,948(Claim 5)	Copending Application: 10/562,820(Claim 8)	
The information recording medium according to claim 4, wherein the button control information includes at least one of association information which indicates association with the button image information, display position information which indicates a display position of a button defined by the button image information, and near-by button information which indicates a change in a state of the button caused by the	The information recording medium according to claim 7, wherein the button control information includes at least one of button image number information which indicates association with the button image information, display position information which indicates a display position on the button menu of a button defined by the button image information, and near-by button information which indicates a change in a state of the button caused by the operation.	

operation.		
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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph because they claim both an apparatus and the method steps of using the apparatus.

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. *IPXL Holdings v. Amazon.com, Inc., 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) *(claim directed to an automatic transmission workstand and the method * of using it * held ** ambiguous and properly rejected under 35 U.S.C. 112, second paragraph).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21 and 22 are rejected under 35 U.S.C. 101, claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.

Claim 24 is directed towards a data structure. A data structure is descriptive material that can be considered statutory only if it is both functional and clearly embodied on a computer readable medium and meets the IEEE definition for data structure (a physical or logical relationship among data elements, designed to support specific data manipulation function) (See MPEP 2106). When functional descriptive material is recorded on some computer-readable medium it will become structurally and functionally interrelated the medium and will be statutory in most cases since the use of technology permits the function of the descriptive material to be realized. See *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031, 1035 (Fed. Cir 1994) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQd at 1759. A data structure is functional if the specific arrangement of data in data enables a computer to accomplish some useful result arising from the arrangement of the data the data structure. However, even if the data structure of claim 24 is functional, it is not clearly defined as being embodied in a computer readable medium and is therefore not statutory. See *Warmerdam*, 33 F.3d at 31360, 31 USPQ2d at 1759.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-12, 14-17, 21-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Setogawa, EP 0898279.

Regarding Claim 1, Setogawa discloses the claimed aspect of an information recording medium on which there are recorded (Abstract): Content information; button information for defining a button menu which allows an operation as for said content information (Setogawa, FIG. 3); and play list information for defining reproduction sequence of said content information by a unit of item (FIG. 3, Scene1, Scene2), which constitutes said content information and which is accessible upon reproduction, said button information including a plurality of button pages each of which can constitute the button menu and whose display can be changed to each other (Setogawa, FIG. 3, Scene1, Scene2, Next Page, Paragraph 0115, FIG. 10, FIG. 8).

Regarding Claim 3, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of button pages includes button command (FIG. 3, Scene1, Scene2, and Next Page) information for defining the operation.

Regarding Claim 4, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of at least one of the plurality of button pages includes button control information being associated with at least one button image information which is displayed and outputted as the button

menu(FIG. 3, Scene1, Scene2), and for displaying and outputting the button image information(FIG. 3, Scene1 is selected at step image displayed at step 4 actual replay provided. (FIG. 3, Paragraph 0115).

Regarding Claim 5, most of the limitations have been met in the rejection of Claim 4. See details for Claim 4 rejection. Setogawa discloses the claimed aspect of button control information includes at least one of association information which indicates association with the button image information(FIG. 4, 11 is related to 15(image) display position information which indicates a display position of a button defined by the button image information(FIG. 4, 15(image) is related to 22(Chapter1), and near-by button information which indicates a change in a state of the button caused by the operation, wherein the selection of BTN#1 changes the state of the button. (Setogawa, FIG. 4, Paragraphs 0084-0088).

Regarding Claim 6, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of said button information is displayed, with it superimposed on or in place of one portion of said content information(Setogawa, FIG. 3, 4, Scene1 and Scene2 is on the content information) or is not displayed at all, selectively in accordance with external designation.

Regarding Claim 7, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa discloses the claimed aspect of said button information is recorded together with said content information(FIG. 10, relationship

between button information and content is illustrated), in a content space in which said content information is recorded and which occupies one area of a recording area in FIG. 3, 4, 6, 10, 20, wherein menu button is used for replaying information on the recording medium. (Setogawa, Paragraphs 0001, 0003).

Regarding Claim 8, most of the limitations have been met in the rejection of Claim 1. See details for Claim 1 rejection. Setogawa, discloses the claimed aspect of on which there is further recorded background image(FIG. 3, FIG. 4, background image, house) information for defining a background image on which the button menu is superimposed and displayed, wherein Scene1 selection is displayed on the background image.

Regarding Claim 9, the steps to achieve information recording medium achieves the information recording apparatus. The rejection for Claim 1 applies to Claim 9. See the rejection details for Claim 1.

Regarding Claim 10, most of the limitations have been met in the rejection of Claim 9. See details for Claim 9 rejection. The steps to achieve information recording medium achieves the information recording apparatus. The rejection for Claim 6 applies to Claim 10. See the rejection details for Claim 6.

Regarding Claim 11, the rejection for Claims 1 and 9 apply to Claim 11. See rejection details for Claims 1 and 9.

Regarding Claim 12, Setogawa discloses an apparatus achieves the claimed aspect, the rejection for Claims 1 and 3 apply to Claim 12. See rejection details for Claims 1 and 3.

Regarding Claim 14, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 5 applies to Claim 12. See rejection details for Claim 5.

Regarding Claim 15, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. The rejection for Claim 6 applies to Claim 15. See rejection details for Claim 6.

Regarding Claim 16, most of the limitations have been met in the rejection of Claim 12. See details for Claim 12 rejection. Setogawa discloses the claimed aspect of a buffer memory for storing the generated button menu in FIG. 13, wherein display memory 118 and 119 is illustrated. (Setogawa, Column 19, Paragraph 0119).

Regarding Claim 17, the rejection for Claims 1, 3, 4 apply to Claim 17. See the rejection details for Claims 1, 3 and 4.

Regarding Claims 21 and 22, the rejection for Claims 1, 3 and 4 apply to Claim 21 and 22. See rejection details for Claims 1, 3 and 4.

Regarding Claim 24, Setogawa discloses the claimed aspect of data structure in FIGS. 6-10. The rejection for Claim 1 applies to Claims 24. See rejection details for Claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- 1) Nomomura et al., US 6,574,419, 06/03/2003, "Optical disk, reproduction apparatus reproduction method, and recording medium".
- 2) Saeki, et al., EP0886276, 03/1997, "Multimedia optical disc having improved interactive reproduction procedure, a reproduction apparatus and method for such a disc".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ECE HUR whose telephone number is 571 270-1972. The examiner can normally be reached on MONDAY-THURSDAY 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ece Hur
E.H./e.h.

February 20, 2008

/Ba Huynh/

Primary Examiner, Art Unit 2179